

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VALERY A. PETRUSHIN

Appeal No. 2005-1941
Application No. 09/833,301

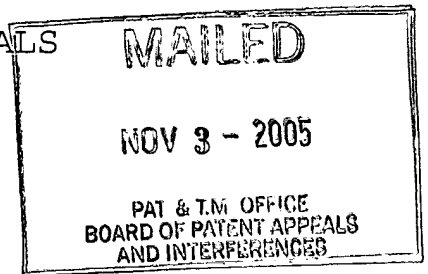
ON BRIEF

Before HAIRSTON, DIXON, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2-4, which are all of the claims pending in this application.

We Reverse.



BACKGROUND

The appellant's invention relates to a device for detecting emotions in a call center (specification, page 1).

Claim 2 is representative of the invention, and is reproduced as follows:

2. A method for monitoring telephonic interactions of an agent with customers, the method comprising:

(a) pre-recording a first speech portion of a telephone call received by an agent,

(b) determining whether said first speech portion satisfies a monitoring condition, and, if so:

(c) recording at least a second portion of said telephone call.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Elazar	6,542,602	Apr. 1, 2003
		(filed Feb. 14, 2000)

Claims 2-4 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking written description.

Claims 2-4 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Elazar.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (mailed

December 1, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief and attached appendices (filed September 15, 2004) and reply brief (filed February 1, 2005) for the appellant's arguments thereagainst.

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of lack of written description and anticipation relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs, including the Appendices, along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with the rejection of claims 2-4 under 35 U.S.C. § 112, first paragraph as lacking written description. The written description requirement serves

"to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

The examiner's position (answer, page 3) is that

The specification fails to support the step of pre-recording a first speech portion of a telephone call received by an agent and determining whether said first speech portion satisfies a monitoring condition" (emphasis original). The examiner asserts (id.) that what the specification discloses on page 26 "or 'throughout the specification' is monitoring the level of nervousness of a person and including an alarm, when it is set off, to trigger a recording device to begin recording the conversation. Appellant's specification is silent on a first portion of the conversation being pre-recorded and that first portion being tested before a second portion is to be recorded.

The examiner adds (answer, pages 3 and 4) that it is critically important to note that the terms "pre-recording", "first speech portion" and "second speech portion" were never part of Appellant's original specification or claims. These terms were copied from the Elazar patent and introduced for the first time in an amendment filed on January 27, 2004.

Appellant's position (brief, page 6) is that in the specification, the inventor is speaking to one skilled in the art, and that therefore, every last detail need not be described. It is asserted (id.) that a specification can be enabling even where some amount of experimentation is needed, so long as the experimentation is not unduly excessive. Appellant lists the Wands factors (id.) that may be used in determining whether the level of experimentation is excessive. It is argued (brief, page 8) that since the specification describes that the alarm could

begin the recording if the conversation is not already being recorded, inherently, it follows that the lack of an alarm could end the recording of a conversation already being recorded. Appellant adds (id.) that "[a]pplicant asserts that based on the amount of direction and guidance presented, such a concept is clearly within the grasp of one skilled in the art." Appellant additionally asserts (id.) that this is especially the case in view of past knowledge regarding recording and detecting emotion in speech signals and further in view of the lack of undue experimentation necessary.

It is argued (brief, page 9) that the features of claims 2-4 do not preclude a continuous recording in which it is determined whether a first portion of the speech recording satisfies a monitoring condition. It is further argued (id.) that step b) includes no limitations to indicate that it is a recording that is used to determine whether a monitoring condition is met, and that since "pre-recording" is not used in step b), it should not be read into step b).

It is additionally argued (id.) that steps a) and b) do not include any limitation indicating that these steps must occur sequentially, simultaneously, or in any particular order.

In addition, appellant argues (response filed May 11, 2004, page 2) that other portions of the specification describe pre-recording a voice signal, and direct our attention to page 34, lines 20-23 and page 57, lines 2-6, among other locations. It is further argued (id., page 3) that

In addition, each of the Claims do not disclose that the first portion is recorded, recording is halted, the first speech portion is used to determine if a monitoring condition is satisfied, and if so, recording of the second portion of the speech portion commences. Instead, each of the Claims indicate that the first speech portion (which is also pre-recorded) is used to determine if a monitoring condition is satisfied." Moreover, in the reply brief (page 3) is argued that in Elazar, the paragraph bridging columns 6 and 7 discloses that "Monitoring system 16 preferably stores captured audio and screen data to one or more storage media 26 and provides captured audio and screen data to one or more supervisor workstations 18 either in real-time or later in a playback mode where audio, screen data, and other data may be monitored separately or simultaneously."

From our review of appellant's specification, we find that all of appellant's arguments regarding enablement are misplaced, as the rejection is based upon a lack of written description, not a lack of enablement. The description requirement exists in the first paragraph of 35 U.S.C. § 112 independent of the enablement

(how to make and how to use) requirement.¹ Page 26, lines 21-23 of the specification recites that "[t]he alarm could also be connected to a recording device which would begin recording the conversation when the alarm was set off, if the conversation is not already being recorded." From our review of this passage of the specification relied upon by appellant, we find that two scenarios are described. The first is when the conversation is not being recorded, and recording begins when the alarm is set off. The second scenario is when the conversation is already being recorded and continues to be recorded when the alarm goes off. In addition, from the disclosure of page 25 that the voice signals may be captured from a telephone tap, and the additional disclosure of page 26 referring to a customer service representative obtaining the level of nervousness of a customer talking to the customer service representative over the telephone, we find that the embodiment discussed on page 26 relates to a customer talking to a customer service representative over the telephone. From the disclosure on pages

¹ It is well settled that the description and enablement requirements are separate and distinct from one another and have different tests. See In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985); In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977); and In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238-39 (CCPA 1971).

25 and 26, we find that the portion of the conversation recorded before the determining of the monitoring condition is a pre-recording of a first speech portion, as a portion of the speech already being recorded is needed for the determining of whether the first speech portion satisfies a monitoring condition.

Appellant also directs our attention to page 34, lines 20-24 and page 57, lines 2-6. Page 34, lines 20-24 disclose that in the simpler embodiment of figure 9, acoustic signals are transduced by a microphone into electric signals which are recorded in a tape recording device. Page 57, lines 2-6 disclose that in operation 2002, the voice messages are stored on a tape recorder or a hard drive, and that an emotion associated with the voice signals of the voice messages is determined in operation 2004, and further that the emotion may be determined by any of the methods set forth, above.

From our review of the embodiment of figure 9, referred to on page 34 of the specification, we find that the acoustic signals are transduced by a microphone 900. We find no specific disclosure of a telephone in this embodiment. From the disclosure of page 57, which relates to the embodiment of figure 20, we find that this embodiment relates to voice received over a telecommunications network. However, even though it is disclosed

in this embodiment that the incoming voice messages are stored on a tape recorder and used to determine the emotion of the caller, we find no clear disclosure that feedback from the taped voice message is used by customer service to record a later portion of the same telephone call. We observe that the specification (page 57), recites that the voice messages may follow a telephone call. Thus, these portions of pages 34 and 57 of the specification are not very helpful to us in determining written description for the claimed invention.

In addition, appellant's broad reference (brief, page 4) to "throughout the specification" is not very helpful to us as the specification exceeds 100 pages in length. Nevertheless, although not brought to our attention by the examiner or appellant, we find, sua sponte, from our review of the specification, that page 42, lines 3-6 recite that "[r]eferring now to Figure 12 of the drawings, a vocal utterance is introduced into the vocal sound analyzer through a microphone 1210 . . . or from a taped input through tape input jack 1212 for use of a pre-recorded vocal utterance input."

From the disclosure that the vocal utterance is received through a microphone or from taped input for use of a pre-recorded vocal utterance input, we find that this portion of the

specification does not recite that the voice is recorded from a telephone conversation. Although it may have been obvious to record a telephone call instead of simply picking up the voice from a microphone, the standard for written description is not obviousness, but rather whether appellant was in possession of the invention.

However, from the disclosure of page 42, we do not agree with the examiner (answer, page 3) that "pre-recording" was never part of appellant's original specification. In addition, although we do not find the specific terms "first speech portion" and "second speech portion" verbatim in the specification, from the disclosure on page 26 that when the conversation is already being recorded and the alarm condition is met, that the conversation is (continues to be) recorded, we find that the specification provides basis for the first and second speech portions, as portions of the speech are being recorded before and after the determining step, if the speech satisfies a monitoring condition.

Turning to the language of claim 2, we find that as broadly drafted, the claim does not require that the recording stops after a first portion is pre-recorded. However, from the language "a first speech portion" in step 1), and "said first

speech portion" in step b) we find that the claim requires step b) to occur after step a). In addition, from the language in step b) of "if so" we find that step c) only occurs if step b) is met. Thus, we find that step c) follows step b).

Although the claim does not require that the recording stops after the first speech portion is pre-recorded, we agree with the examiner that the steps as recited in claim 2 are required to be carried out in the order set forth in the claim, and do not agree with appellant that the steps a) and b) need not be performed in any particular order, because the language of the claim requires the steps to be carried out in the order recited. Accordingly, we agree with the examiner (answer, page 6) that the language of the claim requires the steps to be carried out in the order recited.

Nor do we agree with appellant (brief, page 9) that step b) does not require the pre-recorded first speech portion of step a). The language of step b) refers to "said" first speech portion. Turning to step a), the only antecedent basis in the claim for the "said" first speech portion is the pre-recorded first speech portion of step a). Accordingly, we agree with the examiner (answer, page 5) that step b) requires the pre-recorded first speech portion of step a). Turning back to the language of

claim 2, we note that step c) recites "recording at least a second portion of said telephone call." The language as recited does not require a turning on of the recorder, but rather, as broadly drafted, is broad enough to read on the recorder continuing to record the telephone call. From all of the above, we find from the disclosure on pages 25 and 26 that appellant's specification provides adequate written description for the language of claim 2. Accordingly, the rejection of claim 2 under 35 U.S.C. § 112, first paragraph, is reversed. As steps a) through c) of claims 3 and 4 contain identical language, the rejection of claims 3 and 4 under 35 U.S.C. § 112, first paragraph is reversed.

We turn next to the rejection of claims 2-4 under 35 U.S.C. § 102(e) as being anticipated by Elazar. In view of our reversal of the rejection of claims 2-4 under 35 U.S.C. § 112, first paragraph, we find that appellant is entitled to the benefit of the filing date of parent application 09/388,909 filed August 31, 1999. Since appellant's effective filing date is prior to the filing date of the Elazar reference, it follows that the rejection under 35 U.S.C. § 102(e) is reversed.


Upon return of the file to the examiner, the examiner should consider the Request for Declaration of Interference.

SUMMARY

The decision of the examiner to reject claims 2-4 under 35 U.S.C. § 112, first paragraph and 35 U.S.C. § 102(e) is reversed.

REVERSED


KENNETH W. HAIRSTON
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge


STUART S. LEVY
Administrative Patent Judge

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